UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,207	03/13/2007	Stefan Golz	004974.01212	2782

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EXAMINER
CHEU, CHANGHWA J

ART UNIT	PAPER NUMBER
1641	

MAIL DATE	DELIVERY MODE
05/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/588,207	GOLZ ET AL.
Office Action Summary	Examiner	Art Unit	
	JACOB CHEU	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 August 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18 and 21-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) <u>1-18 and 21-23</u> are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Restriction is required under 35 U.S.C. 121 and 372.

        This application contains the following inventions or groups of inventions which are not
so linked as to form a single general inventive concept under PCT Rule 13.1.

        In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a
single invention to which the claims must be restricted.

Group I, claim(s) 1, 4-11, drawn to a method of screening for therapeutic agent, with a special
technical feature of detecting the binding of the compound to the PRSC1 peptide.

Group II, claim(s) 2, drawn to a method of screening for therapeutic agent, with a special
technical feature of determining the activity of the PRSC1peptide at a concentration of the test
compound.

Group III, claim(s) 3, drawn to a method of screening for therapeutic agent, with a special
technical feature of of determining the activity of the PRSC1 peptide at a concentration of a
known regulator of PPARD peptide.

Group IV, claim(s) 12-17, drawn to drawn to a method of screening for therapeutic agent, with a
special technical feature of detecting the binding of the test compound to the PRSC1
polynucleotide.

Group V, claim(s) 18, drawn to drawn to drawn to a method of screening for therapeutic agent,
with a special technical feature of detecting the amount of PRSC1 peptide.

Group VI, claim(s) 21, drawn to a pharmaceutical composition which regulates the activity of the
PRSC1.

Group VII, claim(s) 22-23, drawn to a pharmaceutical composition comprising PRSC1.

2.   The inventions listed as Groups I-VII do not relate to a single general inventive concept
under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special
technical features for the following reasons:

> With respect to Group VII, Roodman et al. teach a polypeptide PRSC1 (SEQ ID No. 4, WO
> 9828423; note Applicant listed in the specification, See Background of the invention, line
> 12). Roodman teach nucleotide encoding the PRSC1 amino acid (See claims 16 and 19).
> Also for invention VI, Roodman teach an antibody recognizing PRSC1 polypeptide (See
> claim 28). Furthermore, each group contains special technical feature not required by the
> other group.

> Therefore, the invention of Group I-VII do not fulfill the requirement for unity of
> invention under Rule 13.1 PCT. Accordingly, the method of preparing or analyzing or
> are not so linked as to form a single general inventive concept.

> Applicant is advised that the reply to this requirement to be complete must include (i) an
> election of a species or invention to be examined even though the requirement be
> traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected
> invention.

> The election of an invention or species may be made with or without traverse. To reserve
a right to petition, the election must be made with traverse. If the reply does not distinctly and
specifically point out supposed errors in the restriction requirement, the election shall be treated
as an election without traverse.

> Should applicant traverse on the ground that the inventions or species are not patentably
distinct, applicant should submit evidence or identify such evidence now of record showing the
inventions or species to be obvious variants or clearly admit on the record that this is the case. In
either instance, if the examiner finds one of the inventions unpatentable over the prior art, the
evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

3.   Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

        Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Cheu whose telephone number is 571-272-0814. The examiner can normally be reached on 9:00-5:00.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacob   Cheu/
Examiner, Art Unit 1641

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	10/588,207	GOLZ ET AL.	
	Examiner	Art Unit	
	JACOB CHEU	1641	

Index of Claims

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Claim		Date		Claim		Date		Claim		Date
Final	Original			Final	Original			Final	Original	